

# FALK & FISH

ROBERT HARDY FALK, P.C.  
RONALD C. FISH, P.C.

G. BYRON JAMISON, SPECIAL COUNSEL

ATTORNEYS AND COUNSELORS  
INTELLECTUAL PROPERTY LAW

ATTORNEYS AT LAW  
A TEXAS LIMITED LIABILITY PARTNERSHIP

CHATEAU PLAZA  
2515 MCKINNEY AVE, SUITE 1565  
DALLAS, TEXAS 75201

TELEPHONE (214) 954-4400  
FACSIMILE (214) 969-5941  
Internet: <http://www.patent.net>  
E-Mail: [falk@patent.net](mailto:falk@patent.net)

September 26, 2000

OFFICES IN DALLAS, TEXAS  
AND SAN JOSE, CALIFORNIA

MAILING ADDRESS  
P.O. BOX 794748  
DALLAS, TEXAS 75379

#29/14, Third  
Supl. Statement  
of Prior Art

**VIA FEDERAL EXPRESS**

Examiner Stephen Funk  
United States Patent and Trademark  
Office Group 2854  
Room 9D35- Crystal Plaza IV  
Arlington, VA 22202

1-30-01

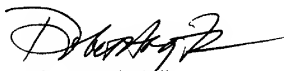
L. Spruell

Re: *Bill L. Davis, et al*; United States 09/315,796;  
Our File No. Will 2501

Dear Examiner Funk:

Enclosed please find Reissue Applicants' Third Supplemental Statement of Prior Art and Other Information concerning U.S. Patent 5,638,752 to Hartung, et al. which came to reissue applicant's attention very recently. Please read this patent carefully prior to the next office action or allowance of the case. I submit also decorations of Williamson, Doughty, Bowyer and expert Prince in support of our position that the '752 patent must be removed as a reference.

Very truly yours,



Robert Hardy Falk

RHF/vm  
Enclosure(s)

RECEIVED - SEP 27 2000

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Reissue Application of: §  
BILL L. DAVIS and JESSE S. WILLIAMSON §  
§  
For Reissue of U.S. Patent 5,630,393 § Group Art Unit:  
Issued May 20, 1997 § 2854  
Serial No. 08/515,097 §  
§ Examiner:  
Filing Date: May 20, 1999 § S. Funk  
§  
Serial No: 09/315,796 §  
§  
For: COMBINED LITHOGRAPHIC/ §  
FLEXOGRAPHIC PRINTING §  
APPARATUS AND PROCESS §  
§

REISSUE APPLICANTS' THIRD SUPPLEMENTAL  
STATEMENT OF PRIOR ART AND OTHER INFORMATION

To: The Honorable Commission of  
Patents and Trademarks  
Washington, D.C. 20231

Sir:

Reissue Applicants wish to bring to the attention of the Patent and Trademark Office U.S. Patent 5,638,752 to Hartung et al. (**Exhibit "A"**) of MAN-Roland Drucksmashinen A.G. ("MAN-Roland") very recently disclosed to applicants based upon an April 3, 1993 German priority application, application DE 93-05552U, a copy of whose priority application and translation is attached hereto as **Exhibit "B"**. One notices that the German priority document omits much of the text of Serial No. 507,7846 and Fig. 2 of the '752 patent.

Reissue Applicants maintain, *inter alia*, that Fig. 3 and Col. 5, line 54 to Col. 6, line 10 and at least claims 2 and 4 of the '752 came from Jesse Williamson, one of reissue applicants, in a visit to a MAN-Roland German plant on May 27, 1992. This visit was the first of a number of visits by Williamson and Harry Bowyer of Wolstenholme International (U.K.) to discuss Williamson Printing Corporation's (WPC) prior art WIMS process (U.S. Pat. 5,370,976 of record) and to motivate Wolstenholme to use WIMS in the forthcoming IPEX Exhibition in September 1993 in England. It is hornbook law that, despite former 35 U.S.C. § 104, an applicant may introduce evidence of events abroad to show derivation by a foreign-based patentee or publisher, as establishing origin of invention -- this is completely different than establishing a date of invention based on old § 104. *Hedgewick v. Akers*, 497

09315796.051801

09315796.051801

F.2d 905, 907, 182 USPQ 167, 182 (CCPA 1974); *Ex parte Lemieux*, 115 USPQ 148 (Bd. Of App. 1957).

The derivation is proven and corroborated in the attached declarations of Jesse Williamson (**Exhibit "C"**), Wolstenholme executive Harry Bowyer (**Exhibit "D"**) and Gary Doughty (**Exhibit "E"**). Jesse Williamson and Gary Doughty embarked on a trip to Germany (Doughty Decl. ¶ 2, Williamson Decl. ¶ 3) to try to encourage MAN-Roland to utilize the WIMS process. They were accompanied by Harry Bowyer, an executive with Wolstenholme. After visiting several color separation/boutique color repro companies doing "Hi-Fi" work (Bowyer Decl ¶ 3, Williamson Decl. ¶ 2), they visited MAN-Roland. During the MAN-Roland visit, and seeing a MAN-Roland prototype 706 press with a tower-coater equipped with an anilox roller at end-of-press (Williamson Decl. ¶ 7; Bowyer Decl. ¶ 3) Jesse Williamson suggested the possibility of using the tower-coater with anilox roller "up front" in a lithographic press to the two German MAN-Roland executives at the plant, and Williamson had further discussions about the concept with one of the two Germans at dinner. Williamson Decl. ¶ 7. Doughty and Bowyer each corroborated the assertion of Williamson that Williamson discussed the possibility of going "up front" in the offset lithographic process with a flexographic step in the automobile after the visit. Doughty Decl. ¶ 4, Bowyer Decl. ¶ 3.

Following the trip and the return of Jesse Williamson to the United States, Jesse had further detailed discussions with Bill Davis, who suggested the use of a modified conventional "rack-back." Williamson Decl. ¶ 8.

Bowyer visited reissue applicants' facilities in October 1992 concerning WIMS and the forthcoming IPEX Exhibition and again went over the concept of going "up front" with an anilox flexographic printer/coater. Reissue applicants discussed various ways this could be accomplished - a dedicated station, an auxiliary "rack-back" device or a device like a "T-Head."

The '752 patent appears to pertain to nothing other than the prototype Roland 706 coater seen by reissue applicants Williamson in late May 1992, equipped end-of-press with a tower coater with an anilox roller.

09316796.051801

The '752 discloses in Fig. 3 at Col. 5-6 Williamson's thoughts. It is hornbook law that an inventor's own prior work will not anticipate his later invention unless that prior work is such as to constitute a [§ 102(b)] statutory bar. Chisum, 1 Patents § 3.08 [2] (May, 1988). One can establish derivation other than through the communication of a complete conception. *Hedgewick v. Akers*, *supra*, 497 F.2d at 908, n. 4 and cases cited therein.

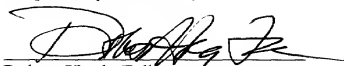
The '752 patent discloses less than what was suggested to the Germans by Jesse Williamson – it doesn't even teach an anilox roller. In fact, it doesn't even discuss an interstation drying step, doesn't discuss the advantages of the invention, or perfecting. According to expert Prince, the '752 patent is clearly non-enabling. Prince Declaration, **Exhibit "F," ¶¶ 4-8 and 13-14.**

The German Roland team filed a second patent application leading to U.S. Patent 5,476,042 (**Exhibit "G"**) teaching the rest of their coating technology that should have been disclosed in the '752 patent series. The '042 patent teaches that each of the end-of-press coaters can be "convertible" – anilox or not. In view of the '042, the '752 patent is clearly invalid under 35 U.S.C. § 112, 1<sup>st</sup> paragraph (best mode, lack of enablement).

Examination of various Roland 700 brochures published since 1993 (**Group Exhibit "H"**) shows that Roland never offered in its brochures an anilox roller or other flexo unit "up front" as suggested in Fig. 3 of the '752 Hartung et al. patent. In fact, it appears that Roland first sold its MAN-Roland 700 with the end-of-press double coater in May 1995 (Graphic Arts Monthly, June 1995 at pp. 40 et seq., **Exhibit "I"**).

The testimony of Williamson, Bowyer and Doughty remove Hartung et al. '752 as a reference. *Lemieux, Hedgewick, supra.*

Respectfully submitted,



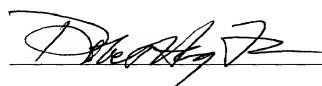
Robert Hardy Falk  
Registration No. 27,877  
FALK & FISH, L.L.P.  
A Texas Limited Liability Partnership  
P.O. Box 794748  
Dallas, Texas 75397  
Telephone: (214) 954-4400  
Facsimile: (214) 969-5941

ATTORNEY FOR PETITIONERS BILL L.  
DAVIS AND JESSE S. WILLIAMSON

CERTIFICATE OF SERVICE

This is to certify that the foregoing Reissue Applicants' Third Supplemental Statement of Prior Art and Other Information was served on '363 Protectors' and '713 Patentees' counsel of record by placing a true and correct copy in the United States Mail, postage prepaid, on the 27<sup>th</sup> day of September, 2000, addressed as follows:

William D. Harris, Jr., Esq.  
Locke Liddell & Sapp LLP  
2200 Ross Avenue, Suite 2200  
Dallas, Texas 75201-6776



09315796-051801